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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/180,132	05/24/99	KIM	H 15280-261004

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EXAMINER	
BADIO, B	
ART UNIT	PAPER NUMBER
1616	
DATE MAILED: 11/05/01	

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Applicati n N .

09/180,132

Applicant(s)

KIM ET AL.

Examin r

Barbara P Badio, Ph.D.

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 3,8-14,20-25 and 28-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1,2,4-7,15-19,26 and 27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

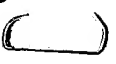
- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

First Office Action on the Merits of a Continued Prosecution Application

Continued Prosecution Application

1. The request filed on October 1, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/180,182 is acceptable and a CPA has been established. An action on the CPA follows.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

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3. Claims 1, 2, 4-7, 15-19, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torelli et al. ('695). 

Torelli et al. teach a generic group of 19-nor steroid derivatives including 11-(4-N, N-dimethylaminophenyl)pregn-4,9-dienes (see the entire article, especially Table I, cols. 15 and 16, compound #10). The reference teaches (a) an equivalent between groups such as alkoxy, acyloxy and hydroxyl in the 17 α -position (see col. 3, lines 3-17, lines 53-65) and (b) several properties of the compounds including their antiprogestational and progestational activities (col. 38, line 67 – col. 39, line 8).

The instant claims differ from the reference by reciting compounds not exemplified by the reference. However, as stated above, the reference teaches an equivalent between various substituents in the 17 α -position. For example, the

Art Unit: 1616

reference teaches an equivalent between (a) hydroxyl, alkoxy and acyloxy in the 17 α -position (col. 3, lines 3-5) and (a) methyl, ethyl, propyl, etc. in the 13-position (col. 2, lines 15-19). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the present invention, to select any of the species of the genus taught by the reference, including those of the instant claims, with the reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as the genus as a whole as taught by Torelli.

- M 4. Claims 1, 2, 4-7, 15-19, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peeters ('787).

Peeters teaches a generic group of 11-substituted 4,9-dienes, including 11-(4-N,N-dimethylaminophenyl)pregn-4,9-dienes and their use as antiglucocorticoid agents in the treatment of anxiety (see the entire article, especially col. 1, lines 6-8, line 54 – col. 2, line 54; col. 3, lines 16-50). The reference teaches an equivalent between hydroxyl, alkoxy, acyloxy and alkyl in the 17 α -position (see col. 2, lines 20-22).

The instant claims differ from the reference by reciting compounds not exemplified by the reference. However, as stated above, the reference teaches an equivalent between various substituents in the 17 α -position. For example, the reference teaches an equivalent between (a) hydroxyl, alkoxy and acyloxy in the 17 α -position (col. 3, lines 3-5) and (a) methyl and ethyl in the 13-position (col. 2, lines 53). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the present invention, to select any of the species of the genus taught by the

reference, including those of the instant claims, with the reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as the genus as a whole as taught by Peeters.

5. Claims 1, 2, 4-7, 15-19, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scholz et al. ('036).

Scholz et al. teach a generic group of 11-substituted 4,9-dienes, 11-(4-N,N-dimethylaminophenyl)pregn-4,9-dienes and their use as antigestagens and, thus, for triggering abortions, inducing birth and treatment of endometriosis, dysmenorrhea and hormone-associated tumors (see the entire article, especially col. 1, line 15 –col. 2, line 20; col. 3, lines 7-34; col. 4, lines 18-20, compound Q). The reference teaches an equivalent between hydroxyl, acyloxy and alkyl in the 17 α -position (see col. 2, lines 3-53).

The instant claims differ from the reference by reciting compounds not exemplified by the reference. However, as stated above, the reference teaches an equivalent between various substituents in the 17 α -position. For example, the reference teaches an equivalent between (a) hydroxyl and acyloxy in the 17 α - position (col. 2, lines 3-53) and (a) methyl and ethyl in the 13-position (col. 1, lines 67-68). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the present invention, to select any of the species of the genus taught by the reference, including those of the instant claims, with the reasonable expectation that

Art Unit: 1616

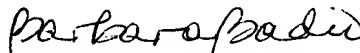
any of the species of the genus would have similar properties and, thus, the same use as the genus as a whole as taught by Scholz et al.

Telephone Inquiry

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P Badio, Ph.D. whose telephone number is 703-308-4595. The examiner can normally be reached on M-F from 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703-308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Barbara P Badio, Ph.D.
Primary Examiner
Art Unit 1616

BB
November 2, 2001